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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,545	03/14/2001	Yuu Suzuki	05905.0133	5622
7590	10/16/2003		EXAMINER	MARKS, CHRISTINA M
Finnegan Henderson Farabow Garrett & Dunner 1300 I Street NW Washington, DC 20005-3315			ART UNIT	PAPER NUMBER
			3713	DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/700,545	SUZUKI ET AL.
	Examiner C. Marks	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 September 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 and 26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 and 26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 26 August 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 26 August 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because no copies of the references have been filed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and those dependent therefrom, it does not appear to be disclosed in the specification that the special action to which the user is given prompts was never before operable during the game. It also does not appear to be disclosed in the specification that the special action will become operable for the first time in the game.

Regarding claims 15 and those dependent therefrom, it does not appear to be disclosed in the specification that the special action to which the user is given prompts was never before operable during the game. It also does not appear to be disclosed in the specification that the special action will become operable for the first time in the game.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoshima et al (US Patent No. 6,241,524) in view of Yamada (US Patent No. 6,149,523) further in view of Applicant's Admission of Prior Art (AAPA).

Aoshima et al. disclose an image processing apparatus and method which includes prompt processing means for outputting a prompt (Abstract) which indirectly teaches and provides training for a key operation corresponding to a special action of a displayed object (FIG 10 and FIG 12) of the game (FIG 10 and FIG 12). The prompt relates to an action other than the special action (FIG 10 and FIG 12) and suggests the key operation to the player.

Aoshima et al. state that the device computes and outputs advice data depending on the state of the game (Abstract) in order to allow the player to master the contents and operational process (Column 1, lines 62-64). Thus, any unfamiliar player can go on in the game, while seeing the advice relating to the game on the screen (Column 2, lines 3-7). Further, a game state judging section is used to select the advice appropriate (Column 2, lines 39-41) to output advice relating to what manner the player must take against the game (Column 2, lines 44-45).

Aoshima et al. also limit the advice so once it has been displayed; it will not be displayed repeatedly and excessively (Column 3, lines 20-25).

Aoshima et al. disclose an image processing apparatus that will provide messages to players based upon the actions of the player to suggest key operation. However, Aoshima et al. lack instructing the player on if the keys they hit were the correct keys associated with the

special action. Further, Aoshima et al. lack a specific disclosure of how key sequences are handled.

Yamada et al. teach of instructing a player on mastering a complicated operating sequence for a game controller operation by providing feedback. Yamada et al. teach of instructing a player in the complicated operating sequence of a game controller by recognizing the player key operation and displaying the input sequence by which the operating buttons are pressed and determining if the sequence matches a standard and correct sequence that is specified (Abstract, lines 3-9). The system determines whether or not the sequence matches the actions of a displayed object (Abstract, FIG 1C). The determining means can determine that no match has been made and at this point, corrective advice which suggests to the player where they went wrong and includes displaying the displayed object highlighted up to the point where the sequence no longer matched (Column 7, lines 34-36). This can be done a plurality of times. These symbols are for a plurality of keys and are displayed on the screen and are according to the results of the determining means (Column 7, lines 33-35 and FIG 1B).

Yamada et al. also incorporate that when a series of operations is necessary for the key operations; each of those key operations is output in a prompt on the screen (FIG 1B) and shown by the actions of a displayed image (Column 5, lines 27-37). The key operations are output as a result of the determining means. The keys that were correct in the determining means will be highlighted, while the keys that were incorrect, will not be highlighted (FIG 1B). The object displayed includes the key sequence output in the prompt and the action shows the button to be pressed (Column 5, lines 27-37). In this manner, each of the key operations is shown in the key prompt as well as the actions to be performed are displayed in the object by means of color to

highlight the correct symbol, show the proper directions, and the time delays required (Column 5, lines 13-25). Thus, the actions of the displayed object represent the key operations to be hit by the player.

Upon completion, this repeat prompt of the identification symbols are then used to inform the player whether input operations match or do not match based upon the determination (Column 5, lines 50-60). Yamada et al. display these symbols in the same window as the gaming story is displayed. However it would have been obvious to one skilled in the art at the time of invention to incorporate these symbols into their own sub-screen as shown by Miyamoto et al. in order to not interfere with the game presentation or progress. Yamada et al. will display these symbols in the case a match is not affirmed, even when the match determination is made for a plurality of times (Column 4, lines 33-54).

Furthermore, it would have been obvious to one skilled in the art at the time of invention to incorporate the sequence matching means and display prompting for key sequences of Yamada et al. into the player prompting of Aoshima et al. Both Aoshima et al. and Yamada et al. represent systems that are directed at aiding a user in understanding the control of an input device in a gaming system. By incorporating these two systems with an identical purpose, it would be possible to inform the player if his or her input matched the input provided by the prompt. Furthermore, because Aoshima et al. allows for indirect prompting, experienced players would feel less intrusion by the prompting. Likewise, by using indirect prompting as disclosed by Aoshima et al. along with the key sequencing as taught by Yamada et al., one would be able to present the player with an indirect guidance of a key sequence to be performed. Yamada et al. teach that these key sequences are important to master in order to understand how to control the

character in the game. By incorporating these sequence teachings into Aoshima et al., one would be able to indirectly prompt users on how to perform key sequences. One would be motivated to use this indirect prompting in this manner in order to inform players as to how to use the device without being intrusive and thus allowing advanced players to be able to ignore the prompting, or disable it all together, as disclosed by Aoshima et al.

By disclosing key sequences as well as whether or not the sequence is correct to players in an indirect manner, the combination would allow the player to become more skilled at a faster rate, as they would be visually informed of the incorrect, as well as correct, input to the game. This would further increase enjoyment among the players as they would take pleasure in a game much more if they were to improve at a rapid rate due to viable, informative, yet unobtrusive feedback in association with the indirect prompts of key operation. Likewise, these instructions are then presented in a manner in which advanced players could ignore or disable them; henceforth, providing enjoyment to all classes and levels of players.

Though neither Aoshima et al. nor Yamada explicitly state that the special action of the game for which the advice is being presented was never before operable; such functionality is disclosed by the Applicant to be *known* in the art. Taken from the specification, the AAPA states “...existing simulation games include a scene for training in key operations, called “practice mode”. The player can enter this mode during or before the start of the action game, as he or she desires. In this practice mode, the type of keys to be operated and the order in which they are operated or pressed are displayed on the screen in a window format. By pressing the keys in the order indicated, the player causes the displayed object, such as a character, to use the corresponding special techniques. When the key operations correspond to the key operations

indicated cannot be made, the displayed object cannot use the special techniques...The player can practice the key operations until the displayed object can use these techniques.” (Specification, page 2, lines 5-18). Thus, the player is prompted for a special action never before operable the action becomes operable for a first time in the game once all the key operations are correct.

Therefore, as such features are notoriously known in the art of simulation games, it would have been obvious to one of ordinary skill in the art to incorporate such known features into the disclosure of Aoshima et al. in view of Yamada, wherein the player would only be allowed to use moves if they were mastered. One of ordinary skill in the art would be motivated to make this incorporation in order to further aid the goal of Aoshima et al. and Yamada which is to teach a player the moves needed for the game without overburdening the advanced user with moves already mastered. Thus by only allowing moves that are mastered into the game, the player will not be burdened with repeated hints as it would be known by the system the player has mastered the move. The systems of Aoshima et al. and Yamada are drawn to being directed at aiding a user in understanding the control of an input device in a gaming system in order to allow the player to master the contents of the operational process. Yamada discloses detecting the input of a user to determine if they did the move correctly thus making it easy to acquire special techniques (Abstract). Incorporating such a known limitation on a practice round would have been obvious to one of ordinary skill in the art because of the desire of the game designer to maintain control over the means in which Aoshima et al. in view of Yamada display their advice and aide the user while accomplishing the disclosed goal.

By further incorporating the AAPA, the subsequent goals of Aoshima et al. would be met in teaching the player to use a controller by not repeatedly and excessively displaying advice. Likewise, the moves already must be practiced in Yamada to acquire techniques (Abstract); therefore explicitly restricting them from use until mastered would be obvious as a means to further instruct and aide the player. By not allowing the player to use moves until they are mastered, the player would become less frustrated in playing the game. From the teachings of AAPA, when applied to Aoshima et al., the system would further prevent the advice from being displayed repeatedly by not allowing the character to perform the action until it is mastered, thus eliminating advice in the game for those who have mastered the skill, which is already done in the system of Aoshima et al. One of ordinary skill in the art would be motivated to make such incorporations in order to further abide by the teachings of Aoshima et al. that it is not desirable to repeatedly and excessively display prompts in the game, thus by incorporating a practice round and allowing only mastered moves as disclosed by AAPA, the goal would be further met while at the same time allowing the player to enhance their skills out of the game environment.

Furthermore, regarding claims 7, 8, 11-14 and 26, the image processing apparatus is an electronic game apparatus and the storage medium necessarily has a program stored upon it for executing the image processing means.

#### ***Response to Arguments***

In response to the Applicants argument that the specification does indeed describe that the special action to which the user is given prompts was never before operable during the game, the Examiner has reread the section pointed out by the Applicant (pages 14-20; mainly page 19). The Examiner agrees with the Applicant that a player actuates the practice mode and that it is a

training mode for key operations wherein the player is trained on the action using prompts. However, regarding the manner of the rejection that the special action to which the user is given prompts was never before operable during the game, the Examiner is not persuaded by the support shown by the Applicant. The Applicant states that the operating procedures for the techniques are hidden in these prompts wherein the operating procedures for a special technique are not operable (hidden) until after the prompt is provided. This is an interpretation by the Applicant in the current amendment and is not present in the actual specification. To quote the specification referred to as support by the Applicant, "Also, the operating procedures for special techniques are hidden in these prompts. For example, the **meaning** is hidden in the prompt displayed on the monitor 282 in Figure 5, "Take two steps forward, and give a punch and then a kick." The specification goes on to define that the hidden meaning actual means hit the forward button and then the punch and kick button. Therefore, the significance of hidden, claimed by the Applicant to support the fact that the special action to which the user is given prompts was never before operable during the game, is actually used in the specification to mean that the prompt includes a hidden meaning as to what the user should do, where hidden means that the user is not told exactly what to do. What the user is exactly to do is hidden in the meaning of the phrase provided. Therefore, no support exists, as claimed by Applicant that "hidden" means the special actions were never before operable. The new matter rejection remains.

In response to the Applicants argument that the specification discloses that the actions are shown by the practice character, the Examiner is persuaded by the support shown by Applicant and has withdrawn that part of the rejection.

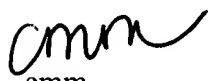
In response to the Applicant's arguments that the references cited do not teach that the special action becomes operable for a first time in the game after the player key operation correctly matches the key operation corresponding to the special action, the Examiner renders the argument moot in view of the grounds of the new rejection provided above and the Applicant's own admission of such art is known in the Background area of the specification.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

  
cmm  
October 7, 2003

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700